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Supreme Court of the United States

OCTOBER TERM, 1950.

No. 108

BLANCHE M. KENYON, INDIVIDUALLY AND AS EXECUTRIX UNDER THE LAST WILL AND TESTAMENT OF BERTRAM C. KENYON, DECEASED,

Petitioner,

vs.

AUTOMATIC INSTRUMENT COMPANY,

Respondent.

RESPONDENT'S BRIEF URGING THAT CERTIORARI BE DENIED.

CLARENCE J. LOFTUS,
WILLIAM E. LUCAS,
135 South LaSalle Street,
Chicago, Illinois,
Counsel for Respondent.

THE GUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

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swinging and turning the clamps to deliver the selected record to and from the turntable. The swinging selector arm supports the jaws. The changer is *itself* selective.

It is stipulated (R. 52):

> "That the issue herein concerns only the record changer that is the mechanism for transferring records from a bank of records onto the turntable for playing and then returning them from the turntable to the bank after playing, to which the claims of the Kenyon, Boa and Green Patent No. 1,879,693 relate."

Respondent's predecessor, through its skilled engineers, did everything that could be done to make the Kenyon, *et al.* changer operate commercially, but without success. The difficulties encountered were insurmountable (R. 80, 81, 161-164, 176-178, 271-274, 292-296, 311-313, 318), and respondent's predecessor, therefore, *was compelled to abandon and discard that type* of changer as being fundamentally wrong in principle, function, mode of operation and mechanism (R. 175). Respondent never made, in a single instance, that type changer, but invented, designed and developed a fundamentally different changer, known as the ARC. Petitioner stipulated (R. 52) that:

> "This (ARC) record changer, its construction and operation, is illustrated and described in the Green Patent No. 2,104,032, filed February 20, 1934, and issued January 4, 1938."

The ARC was the only one made by respondent until May, 1946.

Later, respondent made and sold its Model 500, which is substantially the same changer, so far as transferring records to and from the turntable is concerned. Petitioner stipulated (R. 52) that:

> "This (500) record changer, its construction and operation, is shown and described in the drawings and specifications of the Vanderzee patent application."

The license which respondent acquired when it took over the assets of the previous Delaware corporation only required the payment of royalty on each of *certain changers*. The licensee was never required to pay a royalty on all changers.

The District Court, after a full trial and briefs, found from the evidence, and held, 89 F. Supp. 602, at 609, that respondent's Models ARC and 500 employed *fundamentally and substantially different means and modes of operation,* and, therefore, did not come under the license, and were not within the claims of the Kenyon patent. The Court of Appeals for the Sixth Circuit, after full argument and briefs, affirmed the District Court, 186 F. (2d) 752. The District Court said, 89 F. Supp. 609:

> "The plaintiff contends that defendant is liable for royalties under the December 7, 1925, contract, because it placed a patent notice on its ARC models stating: 'This device is manufactured under one or more of the following patents,' listing 14 patents, including Kenyon. This notice did not necessarily indicate that the device was manufactured under the Kenyon patent. As a matter of fact, the parties stipulated in writing that the construction and operation of the record-changing mechanism in defendant's ARC model was illustrated and described in Green patent 2,104,032. In view of its decision that the record-changing mechanisms employed in defendant's accused machines are not within the claims of the Kenyon patent, the court concludes that the above patent notice does not impose liability on defendant for royalties on its ARC model."

The petition for certiorari points out no reason why that is not true, or that the respondent's Models ARC and 500 are not substantially and fundamentally different in means and mode of operation. Such findings and holdings should dispose of the case, even though the other points referred to in the petition for certiorari are well founded, *which they are not.*

device on which royalties were sought was either identical or substantially the same as the one manufactured during the period for which royalties were paid. There is no such situation here. Both the District Court and the Appellate Court found and held that respondent's Models ARC and 500 were *fundamentally and substantially different in mechanism and mode of operation.*

4. This case involves (a) no question of public importance; (b) no matter of avoiding conflict on the law; (c) no matter affecting the interest of the nation; (d) no case of importance which is in the public interest to have decided by this Court; (e) no principles, the application of which are of wide public and governmental interest; (f) no doubtful question of law of such wide application that this Court should consider, to remove the doubt; (g) no questions as to dominating an industry, concentrated or otherwise, nor any angles of price fixing or anti-trust.

It involves only the question of personal interest in a straight patent license suit, where the District Court and the Court of Appeals, by following the decisions of this and other courts, held that a successor to a licensee was not required to pay royalty where the respondent's predecessor was compelled, because of its complete failure commercially, to abandon and discard the mechanism of the patent, and which it was unable to make operate successfully commercially after many unsuccessful attempts by skilled engineers, and tools, dies and jigs therefor had to be scrapped, and where the only mechanism made by the respondent was substantially and fundamentally different in mechanism and mode of operation from the thing shown, described and claimed in the licensed patent.

5. The petition for certiorari is without foundation, justification or cause, and obviously falls in that class of petitions for certiorari which are characterized as having been filed for delay.

6. There is no conflict of decisions of courts of co-ordinate jurisdiction, and no occasion for this Court's passing on the questions involved in the cases cited on page 7 of the petition because the questions there are in no manner, shape or form involved in the present case.

CONCLUSION.

For the foregoing reasons, petition for writ of certiorari should be denied.

Respectfully submitted,

CLARENCE J. LOFTUS,
WILLIAM E. LUCAS,
135 South LaSalle Street,
Chicago, Illinois,
Counsel for Respondent.